

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

REMARKS

I. Introduction

Pending claims 1-6, 13, 15-18, 26 and 31 have been examined. The Examiner acknowledges that claims 3 and 4 contain allowable subject matter. The Examiner, however, rejects claims 1-2, 5-6, 13, 15-18, 26 and 31. Specifically: claims 13 and 16-18 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite; claims 1, 5-6, 16, 26 and 31 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,838,354 to Yamada et al. (hereinafter “Yamada”); claims 13, 18, 26 and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 0727375 to Orbons et al. (hereinafter “Orbons”); claims 13, 17-18, 26 and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the IP-4000 device¹; claims 13, 17-18, 26 and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the OCE 9400 device; claims 16, 26 and 31 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by JP 63154558² to Takumi (hereinafter “Takumi”); claim 2 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yamada in view of Orbons; and claims 13 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 938,885 to McCulley (hereinafter “McCulley”) in view of U.S. Patent No. 1,128,730 to Smedal (hereinafter “Smedal”).

By way of overview, Applicant rewrites claims 3 and 4 in independent form; overcomes

¹ Applicant submitted a copy of a Brochure for the IP-4000 device to the Patent Office on May 10, 2004.

² Applicant submitted this reference in an IDS filed on February 3, 2004.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

the § 112, second paragraph, rejection of claims 13 and 16-18; and traverses the art rejections of claims 1-2, 5-6, 13, 16-18, 26 and 31 as follows.

II. Allowable Subject Matter

As noted above, the Examiner objects to claims 3 and 4 but acknowledges that claims 3 and 4 contain allowable subject matter and would be allowed if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant rewrites claims 3 and 4 in independent form to place these claims in condition for immediate allowance.

Furthermore, the Examiner does not provide any grounds of rejection for claim 15. Accordingly, it is respectfully submitted that claim 15 is in condition for allowance.

III. Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claims 13 and 16-18 stand rejected under § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner notes that the claims recite a sheet feeding area positioned at a height at which a user does not have to bend substantially at the waist when setting up the printing area. Then, the Examiner asks “What is this height?” According to the Examiner, one of ordinary skill in the art would not be able to determine if he/she were infringing the claims. Applicant respectfully disagrees.

It is respectfully submitted that one of ordinary skill in the art would be able to determine

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

if he/she were infringing the claims by determining whether an exemplary user being approximately 170 cm tall can set up a printing medium for a large printer without having to bend substantially at the waist (*see* claim 13). Furthermore, Applicant amends claims 16 and 18 to further clarify that the user is approximately 170 cm tall.

Therefore, claims 13 and 16-18 are sufficiently definite under § 112, second paragraph.

IV. Claim Rejections – 35 U.S.C. § 102(e)

As noted above, claims 1, 5-6, 16, 26, and 31 stand rejected under § 102(e) as allegedly being anticipated by Yamada.

A. Claims 1 and 5-6

Applicant amends claim 1 to further clarify the height of the user. Claim 1 requires that a large printer have a paper feeding unit capable of feeding a roll of paper, a substantially flat sheet of paper and a stiff carton. It is respectfully submitted that Yamada fails to disclose or suggest a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper and at least one stiff carton, as recited in claim 1.

Instead, Yamada describes a paper feed station 1 that can accommodate a plurality of roll sheets such as roll sheets 101, 102 and 103 (Yamada: Fig. 2; col. 6, lines 34-37). Thus, Yamada fails to disclose or suggest that the paper feed station 1 is capable of feeding anything other than a roll of paper, let alone the recited sheet of paper and stiff carton.

Thus, claim 1 is not anticipated by Yamada for at least the above exemplary reasons. Consequently, claims 5 and 6 are not be anticipated by Yamada at least by virtue of their

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

dependency.

B. Claim 16

As noted above, claim 16 is amended to recite that the user is approximately 170 cm tall.

Thus, claim 16 recites, *inter alia*, "a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, standing in front of the printer can set up a printing medium without having to bend substantially at the waist."

It is respectfully submitted that Yamada fails to disclose or suggest these features of claim 16. For example, Yamada fails to disclose or suggest any relationship between a located height of a paper feeding unit and a user standing in front of the printer. Indeed, the static image conveyed by Fig. 29 of Yamada does not include an illustrated user therein for reference (*c.f.*, Applicant's Fig. 1).

Thus, claim 16 is not anticipated by Yamada for at least the above exemplary reasons.

C. Claims 26 and 31

Claim 26 recites a sheet feeding area operable to feed a plurality of sheets of paper, a substantially flat sheet of paper and at least one stiff carton. Thus, claim 26 is not anticipated by Yamada based on a rationale analogous to that set forth above for claim 1, as well as the additional features recited therein.

For example, claim 26 recites "a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and at least one stiff carton ranging in length from 420 mm to 730 mm." In addition to failing to disclose or suggest a sheet feeding area operable to feed a

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

plurality of rolls, a substantially flat sheet of paper and at least one stiff carton, Yamada fails to disclose or suggest the recited ranges of the print mediums.

Therefore, claim 26 is not anticipated by Yamada for at least the above exemplary reasons. Consequently, claim 31 is not anticipated by Yamada at least by virtue of its dependency.

V. Claim Rejections – 35 U.S.C. § 102(b)

Orbons

Claims 13, 18, 26, and 31 stand rejected under § 102(b) as allegedly being anticipated by Orbons. The Examiner, however, provides no rationale for his conclusory statement that “claims 13, 18, 26 and 31 are clearly anticipated by Orbons” (*see* Office Action: page 2).

A. *Claims 13 and 18*

The Examiner alleges that claim 13 is anticipated by Orbons. Applicant respectfully disagrees.

Claim 13 recites, *inter alia*, "a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level".

Conversely, Orbons describes a channel 35, 36, 37, 48, 49 that is formed at a working height for a standing operator (Orbons: Abstract; and Fig. 1). This channel allows the standing user to place a roll of receiving material 16, 17, 18, 19 having a hollow core 30 in the channel so

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

that a spindle 31 can be introduced into the roll core 30 (Orbons: Abstract). The feed unit 2 of Orbons is located below this channel and thus is below a working height for a standing operator (Orbons: Fig. 1).

Thus, a standing operator in Orbons would necessarily have to bend substantially, *i.e.*, non-negligibly, at the waist in order to load the rolls of receiving material 16, 17 into drawer 14 of the feed unit 2 (Orbons: Fig. 1). Indeed, Orbons expressly discloses that the user must bend in order to introduce the rolls 16, 17 into the drawer 14 (Orbons: col. 5, lines 2-7; Fig. 1).

For at least these exemplary reasons, claim 13 is not anticipated by Orbons. Claim 18 recites features similar to those described above for claim 13 and, thus, claim 18 is not anticipated by Orbons based on a rationale analogous to that set forth above for claim 13.

B. Claims 26 and 31

Claim 26 recites “a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and a stiff carton ranging in length from 420 mm to 730 mm.”

Orbons fails to disclose or suggest a sheet feeding area operable to feed a plurality of paper rolls of the recited dimensions (widths), a substantially flat sheet of paper of the recited dimensions (lengths) and a stiff carton of the recited dimensions (lengths).

Thus, claim 26 is not anticipated by Orbons for at least the above exemplary reasons. Consequently, claim 31 is not anticipated by Orbons at least by virtue of its dependency.

The IP-4000 Device

Claims 13, 17-18, 26, and 31 stand rejected under § 102(b) as allegedly being anticipated

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

by the IP-4000 device. The Examiner, however, provides no rationale for his conclusory statement that “claims 13, 17-18, 26 and 31 are clearly anticipated by the IP-4000 device” (see Office Action: page 3).

A. Claims 13 and 18

Claim 13 recites, *inter alia*, “a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level.”

The Examiner fails to establish that the IP-4000 device discloses or suggests a sheet feeder area positioned in such a manner as recited in claim 13. Thus, claim 13 is not anticipated by the IP-4000 device.

Claim 18 recites features similar to those described above for claim 13 and, thus, claim 18 is not anticipated by the IP-4000 device based on a rationale analogous to that set forth above for claim 13.

B. Claim 17

Claim 17 recites, *inter alia*, “a paper feeding path extending from the paper feeding area to the paper discharge area via the printing area, wherein the paper feeding area is located in an upper rear portion of the printer and the paper discharge area is located in a lower front portion of the printer.”

The Examiner fails to establish that the IP-4000 device discloses or suggests the recited location of the paper feeding area and the paper discharge area, such that a paper feeding path

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

extends from the paper feeding area to the paper discharge area via the printing area. Thus, claim 17 is not anticipated by the IP-4000 device.

C. Claims 26 and 31

Claim 26 recites “a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and a stiff carton ranging in length from 420 mm to 730 mm.”

The IP-4000 device fails to disclose or suggest a sheet feeding area operable to feed a plurality of paper rolls of the recited dimensions (widths), a substantially flat sheet of paper of the recited dimensions (lengths) and a stiff carton of the recited dimensions (lengths).

Thus, claim 26 is not anticipated by the IP-4000 device for at least the above exemplary reasons. Consequently, claim 31 is not anticipated by the IP-4000 device at least by virtue of its dependency.

The OCE 9400 Device

Claims 13, 17-18, 26, and 31 stand rejected under § 102(b) as allegedly being anticipated by the OCE 9400 device. The Examiner, however, provides no rationale for his conclusory statement that “claims 13, 17-18, 26 and 31 are clearly anticipated by the OCE 9400 device” (*see Office Action: page 3*).

Furthermore, it is respectfully submitted that the Examiner fails to establish that the single page printout for the OCE 9400 Device is prior art. In particular, the Examiner fails to establish any effective date for the document, although it is listed with the date of July 2004 on the Form PTO-892 included with the Office Action. Since the present application was filed on

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

August 30, 1999, a document dated July 2004 is not prior art with respect to the claims of the present application.

Therefore, claims 13, 17-18, 26 and 31 cannot be anticipated by the OCE 9400 device since it has not been shown that the OCE 9400 Device is prior art.

Takumi

Claims 16, 26 and 31 stand rejected under § 102(b) as allegedly being anticipated by Takumi.

A. Claim 16

As noted above, Applicant amends claim 16 to recite that the user is approximately 170 cm tall. Thus, claim 16 recites, *inter alia*, "a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, standing in front of the printer can set up a printing medium without having to bend substantially at the waist."

The Examiner alleges that claim 16 is anticipated by Takumi because Takumi discloses a sheet feeding area with an elongative member and a pair of supports pivotable toward the front of the printer (*see* Office Action: page 3). Applicant respectfully disagrees.

For example, Takumi fails to disclose or suggest a sheet feeding area that is positioned at a height at which a user (who is 170 cm tall) standing in front of the printer can set up a printing medium without having to bend substantially at the waist. Indeed, Takumi fails to disclose or even suggest any positioning of a sheet feeding area at a height relative to a user.

Therefore, claim 16 is not anticipated by Takumi for at least the above exemplary reasons.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

B. Claims 26 and 31

Claim 26 recites “a sheet feeding area operable to feed a plurality of paper rolls ranging in width from 210 mm to 1120 mm, a substantially flat sheet of paper ranging in length from 420 mm to 1580 mm and a stiff carton ranging in length from 420 mm to 730 mm.”

It is respectfully submitted that Takumi fails to disclose or suggest a sheet feeding area operable to feed a plurality of paper rolls of the recited dimensions (widths), a substantially flat sheet of paper of the recited dimensions (lengths) and a stiff carton of the recited dimensions (lengths).

Thus, claim 26 is not anticipated by Takumi for at least the above exemplary reasons. Consequently, claim 31 is not anticipated by Takumi at least by virtue of its dependency.

VI. Claim Rejections – 35 U.S.C. § 103(a)

A. Claim 2

Claim 2 stands rejected under § 103(a) as allegedly being unpatentable over Yamada in view of Orbons.

Since claim 1 is not anticipated by Yamada for the reasons set forth above and since Orbons fails to make up for the deficiencies of Yamada (described above with respect to claim 1), it is respectfully submitted that claim 2 is patentable over the proposed combination of Yamada and Orbons at least by virtue of its dependency.

B. Claims 13 and 17

Claims 13 and 17 stand rejected under § 103(a) as allegedly being unpatentable over

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

McCulley in view of Smedal. The Examiner is essentially maintaining his prior rejection of claims 13 and 17.

As an initial matter, it is respectfully submitted that McCulley and Smedal represent non-analogous art in that they both relate to typewriters, which are not large printers, as recited in claims 13 and 17. Typewriters do not generally suffer from the problems encountered by large printers. For example, typewriters would not require a deeper installation space for replacing a paper roll or require that a user replace a heavy roll of paper (*see, e.g.*, Applicant's specification: page 1, line 1 to page 2, line 19). Indeed, Applicant's specification clearly describes the aforementioned exemplary problems encountered by large printers (*see, e.g.*, Applicant's Specification: page 1, lines 5-7; page 1, lines 8-12; page 1, line 25 to page 2, line 5; page 2, lines 12-19; page 2, line 23 to page 3, line 5; and Figs. 1 and 4).

Applicant notes that a reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). The title of Applicant's invention is *Large Printer*. Furthermore, all of the pending claims are directed to large printers (*see, e.g.*, Applicant's claims 13 and 17). Typewriters are not large printers. Consequently, because McCulley and/or Smedal represent non-analogous art, the rejection of claims 13 and 17 under § 103(a) is improper.

Furthermore, the Examiner acknowledges that McCulley fails to teach or suggest "a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level", as recited in claim 13 (*see*

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

Office Action: pages 3-4). However, the Examiner alleges that Smedal makes up for the acknowledged deficiencies of McCulley by disclosing a roll attachment for type writers that includes a frame (5) with a vertical leg (3) adapted to be supported at any elevation (*citing* Smedal: page 1, lines 85-90), including a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, when the printer is placed substantially at ground level, for the purpose of adapting the attachment to any type writing machine.

It is respectfully submitted that the Examiner is mischaracterizing Smedal. For example, Smedal does not disclose a frame (5) with a vertical leg (3) adapted to be supported at any elevation. Instead, Smedal discloses that a frame 5 with a vertical leg 3 adapted to be supported at any desired elevation within the post 2 (*see* Smedal: page 1, lines 86-89; and Fig. 5). Smedal does not disclose or even suggest that an elevation of the vertical leg 3 within the post 2 would position a sheet feeding area of the attachment at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the typewriter and standing substantially at ground level. For at least these exemplary reasons, the proposed combination of McCulley and Smedal does not render the subject matter of claim 13 obvious. Consequently, claim 17 is patentable over McCulley and Smedal at least by virtue of its dependency.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/386,000
Attorney Docket No. Q55595

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Billy Carter Raulerson
Registration No. 52,156

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 1, 2004

Client: 265550 - NGB CORPORATION
Matter: Q55595 - S54-116595M/MTV (F004542US/TP)

DEBIT NOTE BREAKDOWN

Total disbursements: \$ 426.21
Total services: \$ 3,173.00 Seiko Epson/Fuji Discount Counted
Correctly ____
Total fixed fee: \$ 30.00

Total for debit note: \$ 3,629.21

 Atty Sec.
Initials

Client: 265550 - NGB CORPORATION
Matter: Q55595 - S54-116595M/MTV (F004542US/TP)

DEBIT NOTE BREAKDOWN

DISBURSEMENTS		SERVICES	TIME	FIXED FEE
001E Excess Claim Fee	176.00	BCR	2,703.00	0.00
002F Facsimile - Foreign	170.00	DKT	0.00	20.00
003 Duplicating - Intern	82.00	GKR	80.00	0.00
004 Travel	5.00	JAS	390.00	0.00
005 Postage	-24.20	POS	0.00	10.00
011 Courier	17.41	SEKO	-317.30	0.00

Total disbursements:	\$ 426.21	
Total services:	\$ 2,855.70	Seiko Epson/Fuji Discount Counted
Correctly <u>✓</u>		
Total fixed fee:	\$ 30.00	
Total for debit note:	\$ 3,311.91	

Atty Sec.
Initials



2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213
T 202.293.7060
F 202.293.7860
www.sughrue.com

DEBIT NOTE NO:

DATE:

605658

November 1, 2004

CLIENT NO:

2655550

OUR REF:

Q55595

YOUR REF:

S54-116595M/MTV
(FP04542US/00TP)

RE:

USSN 09/386,000

NGB CORPORATION
P.O. Box 521
ARK Mori Building 13F
12-32, Akasaka 1-chome
Minato-ku, Tokyo 107-6013 JAPAN

TO SERVICES:

Review and report Advisory Action to client via fax; telephone Communication on June 4, 2004 with Examiner P. Mackey of the U.S. Patent and Trademark Office to discuss the Advisory Action, wherein the Examiner agreed to issue a new, non-final Office Action; telephone Communication with Examiner Mackey regarding a non-final Office Action being mailed out and requesting an Interview Summary to that effect; forwarded copy of the Interview Summary to the client; telephone Communication on July 12, 2004 with Examiner regarding status of the case; brief review of non-final Office Action and forward to client; telephone Communication on August 9, 2004 with the Patent Office re: errors in the Office Action; fax response to client fax of August 11, 2004; review specification, drawings, claims, non-final Office Action and references; prepare comments on non-final Office Action and fax to client; review instructions in client facsimile of October 29, 2004; prepare Amendment Under 37 C.F.R. § 1.111 and an Excess Claim Fee Payment Letter; file Amendment in the US Patent and Trademark Office and report to the client with copies of the papers as filed

Total Services: \$ 2,885.70

Page 2
S54-116595M/MTV (FP04542US/00TP)

TO DISBURSEMENTS:

Excess Claim Fee	176.00
Duplication, postage and transportation	62.80
Telephone and facsimile	170.00
Courier	17.41

AMOUNT DUE	\$ 3,311.91